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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,365	06/22/2001	Jeffrey M. Cogen	08964/00001	7029
25223	7590	06/07/2005	EXAMINER	
WHITEFORD, TAYLOR & PRESTON, LLP			KRAMER, JAMES A	
ATTN: GREGORY M STONE			ART UNIT	PAPER NUMBER
SEVEN SAINT PAUL STREET				
BALTIMORE, MD 21202-1626			3627	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/887,365	COGEN, JEFFREY M.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Kramer	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 25 March 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-19,22,25-32,35,38-45,48 and 51-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19,22,25-32,35,38-45,48 and 51-66 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8, 12-14, 16-17, 19, 22, 27-30, 32, 35, 38-40, 42-43, 45, 48, 52, 54-56, 58, 59, and 61-63 are rejected under 35 U.S.C. 102(a) as being anticipated by Handheld

HQ/Supersync/Pocket Rx/Pocket Parts TV Sync by Kliot and Glass (hereinafter Handheld HQ).

Handheld HQ teaches an external infrared transmitter and receiver connected to a computer terminal. A signal is transmitted to or received from the handheld device in order to upload information to or download information from the two devices (i.e. the handheld device and the computer terminal).

Handheld HQ further teaches potential applications for the system. Examiner specifically references Application 16: Restaurant menus can be uploaded either at the restaurant or online to a handheld device. An order can then be entered into the handheld device and uploaded by the consumer at the restaurant (e.g. at the register or at the drive-thru window). Examiner notes that this clearly teaches displaying a menu listing a plurality of items available from a restaurant, receiving selection from the user, storing selection in an order file in a memory storage device on transportable computer and remotely transmitting order file to a receiving terminal at a location of item provider without physical connection between transportable computer and receiving terminal (Independent claims 1, 13, 28 and 39 and dependent claim 43, 52, 55 and 64).

Examiner further notes that the potential application of Handheld HQ includes multiple restaurants (indicated by the terminology “restaurant menus”). As such the reference anticipates selecting a restaurant from among a list (independent claim 54, dependent claims 3 and 4).

Claims 2, 14 and 40, further require that the order file be transferred between the transportable computer and the receiving terminal without telephony or satellite communication. Examiner notes that the infrared teaching of Handheld HQ clearly indicates that the order file is transmitted from the PDA (transportable computer) to the restaurant (receiving terminal) without either telephony or satellite communications.

Claim 5 requires that the menu comprises a listing of all items available for ordering from item provider. Examiner notes it is inherent to the teaching of Handheld HQ, that an entire listing of items available are upload, when the user uploads the menu for a restaurant.

Claim 7 requires that the order file is transmitted via infrared transmission. Examiner once again notes that this is the basic teaching of Handheld HQ.

Claims 8, 17, 30, 56 and 59 require that the order file be formatted for reception by an IrDA compliant infrared receiver. Examiner notes that since the order file of Handheld HQ is sent via an infrared transmission the order file MUST be formatted for reception by an IrDA compliant infrared receiver as there is no other way to transfer the file, as such this limitation is inherent to the teachings of Handheld HQ.

Claims 12, 27 and 38 require that item provider be a restaurant. Examiner once again points to Potential Application 16 of Handheld HQ indicating specific use in a restaurant.

Claims 16, 29, 42 and 61 requires that the transmission receiver be positioned adjacent to a customer drive-through lane. Handheld HQ clearly states that the consumer uploads the order at the drive-thru window (Potential Application number 16).

Claims 19, 32, 45 and 62 require the remote transmission receiver be positioned at a customer service counter. Handheld HQ states that the consumer uploads the order at the

register. Examiner notes that a register is a customer service counter and therefore Handheld HQ anticipates this limitation.

Claims 22, 35, 48 and 63 require the receiving terminal be positioned at a personal customer dining location at said item provider location. Handheld HQ clearly states as an example that the consumer uploads the order at the drive-thru window or at the register. Examiner asserts that Handheld HQ, therefore anticipates the terminal position at a personal customer dining location.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 18, 31, 44, 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of How Infrared Laser Data Transmission Compares with Radio Frequency Transmission (hereinafter Compares).

Handheld HQ, as discussed in detail above, fails to teach remotely transmitting order file via radio frequency transmission. Compares teaches that there are two main wireless transmission methods, infrared laser (taught by Handheld HQ) and radio frequency. Compares further teaches that infrared laser is unsuitable for installation in heavy fog-prone areas. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ by replacing the infrared transmission with radio frequency in order to provide a more robust transmission signal suitable for

installation in heavy fog-prone areas. This would be especially important for installation at a drive-through window.

Claims 6, 11, 15, 25 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of U.S. Patent Number 5,969,968 to Pentel (hereinafter 968).

Claim 6 requires the editing of the previously stored items in the order file. Handheld HQ, as described in detail above fails to teach editing the previously stored items in the order file. 968 teaches a remote ordering system which includes a “remove” key on a remote device. Upon pressing the “remove” key a list of items ordered with item number, description and quantity appears on the screen. The user is then able to use the remote device to select which item to remove (column 4; lines 36-45). Examiner interprets the function of removing an item from the order to be equivalent to editing the order.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the PDA of Handheld HQ to include a “remove” key, which would enable the user to remove (edit) the order file prior to transmitting it to the receiving terminal. One of ordinary skill in the art would have been motivated to add the remove key in order to allow users to change their minds and order different items.

Claims 11 and 25 require the transportable computer to calculate a total price of items in said order file and displaying the total price to the user.

968 teaches in the Abstract (step j) calculating an order total and displaying an order total screen on the display. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to calculate an order total

and display that total to the user as taught by 968 in order for a user to know exactly how much they are going to have to pay for their order.

Claims 15 and 41 require the displaying a message to the customer indication that order has been accepted. Examiner notes that 968's teaching of displaying an order total corresponds to a message indication the order has been accepted. In addition, Examiner references Figure 10, in which the message "Please Pull Forward" is associated with the display of the total. Examiner notes, this message clearly indicates to the customer that their order has been accepted.

As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to include a message from the order terminal indicating to the customer that the order has been accepted as taught by 968, in order for the customer to be assured his/her order was received and is being processed.

Claims 10, 26, 51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handheld HQ in view of U.S. Patent Number 6,208,976 to Kinebuchi et al. (hereinafter Kinebuchi).

Handheld HQ, described in detail above teaches a user uploading a menu at a restaurant or online (Potential Applications 1 and 16). Handheld HQ does not teach receiving a menu update instruction after transmitting an order file to receiving terminal. Kinebuchi teaches an order management system with automatic menu updating. In particular the order management system transmits data to the terminal devices at start up. In this case Examiner notes that the start up described in Kinebuchi is the same as the upload process of Handheld HQ, as this is the "start" of the process. In addition, Examiner notes once again that Handheld HQ teaches a bi-

directional communication system, where the order terminal not only receives the order but is capable of transmitting data.

As such it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Handheld HQ to include the order terminal transmitting data to the terminal device after uploading the order file in order to provide the user with the most current menu.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 65 and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz.

Treyz teaches a shopping assistance computing device where a user with a handheld computing device may interact with a merchant using a local wireless transmitter/receiver associated with the merchant's computer. This allows the user to obtain, for example, information on products and services sold by the merchant (displaying to a user a menu listing of plurality of items available for ordering from an item provider) (column 21, lines 25-35).

Further, Treyz teaches the user of the handheld computing device to order the product (in response to a user instruction to transmit an order file, remotely transmitting said order file to a receiving terminal at a location of said item provider without physical connection between transportable computer and said receiving terminal).

Treyz further teaches an order now features which allows the user to order an item from a store (receiving selection by a user) (column 33, lines 45-54).

Examiner notes that the handheld terminal inherently stores the selection by the user prior to transmitting it to the order fulfillment center. There is no other way for this process to work.

***Response to Arguments***

Applicant's arguments filed 3/25/05 have been fully considered but they are not persuasive. Applicant asserts that the Kliot and Glass reference fails to provide evidence in support of the rejection under 35 USC 102(a). Examiner disagrees and at the very least asserts that the reference provides evidence that the claimed invention was known by another prior to Applicant's earlier priority date.

Applicant further asserts that the Kliot and Glass reference is non-enabling. Examiner disagrees and argues that a reference is presumed to be operable (2121). As such the burden is on the Applicant to provide facts to rebut the presumption. Applicant has not provide a single fact to support this assertion and has such has not met the required burden.

Examiner notes that the rejection to claims 65 and 66 is proper as these are newly amended (added) claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent number 6,317,718 to Fano directed towards a system, method and article of manufacture for location-based filtering for shopping agent in the physical world

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

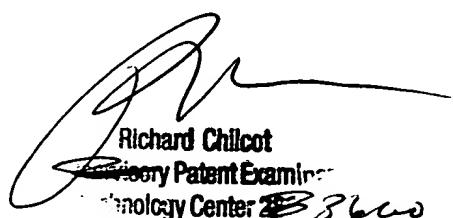
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272 6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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jak



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